

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner has objected to the specification, namely on page 18, line 22, where the "external part" was mistakenly labeled "90" instead of "92". The specification has been amended, making this objection moot.

Claims 1-8 remain in this application. Claims 9-21 have been added to claim additional features from the specification. Claim 1 has been amended for clarification and grammatical reasons.

Claims 1-5 and 8 were rejected under 35 U.S.C. §102(e) as being anticipated by Seal *et al.* (U.S. 6,333,988 B1). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites an iris camera module comprising an "image pickup optical system for picking up an image of the iris" and a "target optical system for displaying a target for the eye". Claim 1 further recites that "the target optical system and the image pickup optical system are integrated into a single unit". The cited reference does not teach the invention of claim 1.

The Examiner cites Seal as teaching the limitations of the claim. However, Seal does not teach a "target optical system" feature that is "integrated" into a "single unit". Instead, Seal teaches a "line of sight" optical system (col. 7, lines 4-11). Seal suggests that its device might also provided a "screened image of the environment beyond the apparatus" by using the LCD display of a CCD camera, for example (col. 7, lines 12-21). However, there is no suggestion that this camera be "integrated into a single unit", as claimed. In fact, it is clear that Seal anticipates that this optical system would be separate from the device because it must be "mounted" on the device. See *Id.* at lines 16-17. Accordingly, Seal does not anticipate the invention of claim 1, because it does not teach *all* of the limitations of the claim, and thus claim 1

is patentable over the reference.

Claims 2-8, which depend on claim 1, are thus patentable over Seal for at least the same reasons.

Further, claim 5 recites that "the target optical system includes a screen illuminating section for illuminating the target screen". Seal does not suggest this element of the claim. The Examiner states that an illuminating section is "inherent" to an LCD screen. It is not enough to merely allege that a function or feature is "inherent". The Examiner must provide evidence and or rationale to *show* inherency. MPEP §2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is *not* sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112.

Applicants' representative disputes that an illumination section "necessarily flows" from a teaching of an LCD display screen or that an illumination section is "necessarily present" in an LCD display screen (in fact, applicants representative has a calculator sitting on his desk with an LCD screen that does not have any illumination section, and relies solely on ambient light). Thus, the rejection improperly relies on inherency, and thus claim 5 is patentable over the reference

because the reference does not teach all of the limitations of claim 5.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Seal in view of Cambier *et al.* (U.S. 6,532,298). Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Seal in view of Cambier and in further view of Fisun *et al.* (U.S. 5,862,247). For the following reasons, the rejections are respectfully traversed.

Claim 7 recites that "the reference iris information can be overwritten only a predetermined number of times in the storage". The Examiner cites Fisun. Col. 5, lines 20-25 as teaching this element of the claim. However, a close reading of the cited passage does not support the Examiner's assertion.

Fisun states that

The identification information IA, IB and IC moreover is inscribed into the data carrying media in such a manner, that *its elimination by "overwriting" would be possible only by means of exactly the device which had been used for the original registration.* The inscription of a second, alternate marking would still be impossible.

(emphasis added). Note that Fisun is merely stating that overwriting can only be done by the *same device* used for the original registration. There is no suggestion that the overwriting can only be done a limited *number* of times, as claimed. The paragraph following the above cited paragraph emphasizes this point. Accordingly, Fisun does not teach the cited limitation of claim 7, and thus claim 7 is patentable over the combination of references.

In addition, Fisun does not teach that the identifying information is "iris information" as claimed (in fact, an electronic search of the document shows that Fisun does not use the term "iris" anywhere in the reference). Hence, for this reason as well, claim 7 is patentable over the references.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or

modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

New claim 9 recites that "the target optical system and the image pickup optical system are integrated onto a *common substrate*", and thus the analysis for claim 1 applies to claim 9, and therefore claim 9 is patentable over the references.

New claims 10-16 depend, directly or indirectly, on claim 9, and are thus

patentable for at least the same reasons.

New claims 17 and 19 recite that "the reference iris information can be overwritten only a predetermined number of times in the storage". By the analysis for claim 7 above, none of the reference suggest this element of the claim, and thus new claims 17 and 19 are patentable over the references. New claims 20 and 21, which depend on claim 19, are thus patentable over the reference for at least the same reasons.

New claim 18 recites that "the reference iris information cannot be overwritten". None of the references suggest this limitation, and thus claim 18 is patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33781.

Respectfully submitted,

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